

REMARKS/ARGUMENTS

Claims 1-3, 5, 11-13, 19 and 20 are pending in the present application. Claims 1, 3, 5, 11, 13 and 19 have been amended, and Claims 4, 6-10 and 14-18 have been cancelled, herewith. Reconsideration of the pending claims is respectfully requested.

I. 35 U.S.C. § 112, First Paragraph

The Examiner objected to the specification under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention in claims 4, 8, 14 and 17. Additionally, the examiner rejected the claims under the same reasons. This rejection is respectfully traversed.

Specifically with respect to Claim 4, the Examiner states that user selection of the location where the personal identification information would be stored is not described in the specification, as the specification only describes that a user can save the information. Applicants urge that per the description at page 19, line 19 – page 20, line 5 (and as depicted in Figure 7, blocks 703-707), the receiving phone recognizes the reception of a digital card and determines if the user has pre-set preferences as to saving incoming digital calls (step 703). If the user does have pre-set preferences, the phone automatically saves the incoming digital card according to the preferences.

Claim 1, which is being amended to include features of Claim 4, is being amended in accordance with this specification disclosure. Claim 14 is also being so amended. Claims 8 and 17 have been cancelled herewith without prejudice or disclaimer.

Therefore, the objection of the specification and rejection of Claims 4, 8, 14 and 17 under 35 U.S.C. § 112, first paragraph has been overcome.

II. 35 U.S.C. § 112, Second Paragraph

The Examiner rejected Claims 1-20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. This rejection is respectfully traversed.

With respect to Claims 5 and 10, the Examiner notes antecedent basis issues. Applicants have amended Claim 5 to correct such issues (Claim 10 is being cancelled herewith without prejudice or disclaimer).

With respect to Claims 1, 6, 11, 15 and 19, the Examiner states that without undue experimentation it would not be clear how the second transmission could be sent at the same time as the first transmission. Applicants urge that modulation techniques such as frequency modulation and amplitude modulation allow for such concurrent transmission, and use of such techniques would not

require undue experimentation. In any event, Applicants have amended Claims 1, 11 and 19 in an attempt to address the Examiner's clarity concerns, in accordance with the description at page 18, lines 6-30 of the specification.

Claims 6-10 and 15-18 have been cancelled herewith, without prejudice or disclaimer.

Therefore the rejection of Claims 1-20 under 35 U.S.C. § 112, second paragraph has been overcome.

III. 35 U.S.C. § 102, Anticipation

The Examiner rejected Claims 1-2, 5-7, 10-12 and 15-16 under 35 U.S.C. § 102 as being anticipated by Wu (U.S. Patent No. 6744874). This rejection is respectfully traversed.

Claim 1 has been amended to include certain features from Claim 4 (which is thus being cancelled herewith without prejudice or disclaimer). As to amended Claim 1, Applicants will discuss such claim below with respect to the 35 USC 103 rejection of Claim 4 (as Claim 1 now includes the features of Claim 4).

As to Claims 2 and 5, Applicants traverse for reasons given below with respect to Claim 1 (of which Claims 2 and 5 depend upon).

Applicants traverse the rejection of Claim 11 (and similarly for dependent Claim 12) for similar reasons to those given below with respect to Claim 1.

Claims 6, 7, 10, 15 and 16 have been cancelled herewith.

Therefore, the rejection of Claims 1-2, 5-7, 10-12 and 15-16 under 35 U.S.C. § 102 has been overcome.

IV. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 3-4, 8, 13-14 and 17 under 35 U.S.C. § 103 as being unpatentable over Wu (U.S. Patent No. 6744874) in view of Official Notice. This rejection is respectfully traversed.

Claim 1 has been amended to include certain features from Claim 4 (which is thus being cancelled herewith without prejudice or disclaimer). As to amended Claim 1, such claim recites that the received personal identification information is automatically stored, during the phone call, in either a server or memory on the telephone based on a user preference. The cited reference does not teach or otherwise suggest this claimed feature. The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Although a device may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation *in the reference* to do so. *In re Mills*, 916 F.2d 680, 16 USPQ2d

1430 (Fed. Cir. 1990). There is simply no reason, desire, suggestion or other motivation to modify the teachings of Wu in accordance with the presently claimed invention – absent the hindsight afforded by the disclosure of the present application, which is improper hindsight analysis. Wu does not contemplate any type of automated storage of incoming/received identification information, as Wu expresses a desire to display such information on a display of the receiving device using traditional caller-ID technology (col. 13, lines 27-30 and lines 34-36). Still further, because the information that is received is encoded using FSK or PSK methods (col. 13, lines 32-36) because of Wu's desire to use traditional caller-ID techniques for displaying the received FSK/PSK-encoded information, it would not have been possible to store such information in either the phone or the server (without sophisticated re-encoding techniques which are not conducive to telephone-component processing) as such encoding is not geared toward storage techniques, but rather is geared toward audio processing for speaker output or LCD display. Thus, a person of ordinary skill in the art, when confronted with the teachings of Wu, would not have been motivated to modify such teachings in accordance with the invention of Claim 1 as the encoding techniques required by Wu are not compatible with the storage features recited in Claim 1. It is thus urged that amended Claim 1 is not anticipated by, or obvious in view of, the cited reference.

Applicants traverse the rejection of Claim 3 for reasons given above with respect to Claim 1 (of which Claim 3 depends upon).

Applicants traverse the rejection of Claims 13 and 14 for similar reasons to those given above with respect to Claim 1.

Claims 4, 8 and 17 have been cancelled herewith, without prejudice or disclaimer.

Therefore, the rejection of Claims 3-4, 8, 13-14 and 17 under 35 U.S.C. § 103 has been overcome.

V. 35 U.S.C. § 103. Obviousness

The Examiner rejected Claims 9 and 18-20 under 35 U.S.C. § 103 as being unpatentable over Wu (U.S. Patent No. 6744874) in view of Engelke et al. (U.S. Patent No. 5974116). This rejection is respectfully traversed.

Claims 9 and 18 have been cancelled herewith without prejudice or disclaimer.

With respect to Claim 19 (and similarly for Claim 20), Applicants traverse the rejection of such claim for similar reasons to those given above with respect to Claim 1.

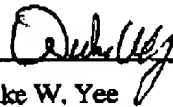
Therefore, the rejection of Claims 9 and 18-20 under 35 U.S.C. § 103 has been overcome.

VI. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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